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EXAMINER

TUCKER, PHILIP C

ART UNIT PAPER NUMBER

1712

DATE MAILED: 03/12/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

924115

Applicant(s)

ALLAN ET AL

Examiner

P. TOCKER

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 - 22 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 - 18, 21, 22 is/are rejected.
- ☒ Claim(s) 19, 20 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

Claim Objections

1. Claim 4 and 12 are objected to because of the following informalities: The compound Kcl should be changed to KCl. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 5, 12, 13 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of these claims utilize the term "selected from the group including", which implies that there are other compounds which are part of the group, but not listed. Proper Markush terminology such as "selected from the group consisting of" should be used.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas (5591701).

Thomas teaches a fluid for use in a wellbore which comprises glycines and betaines within the scope of the present invention, which are used in brines, to which acid is added (see claims, compounds in column 6, column 4, lines 11-18 and Tables II and IV). Applicants intended use as a fracturing fluid does not distinguish over the prior art (In re Pearson 181 USPQ 641).

6. Claims 1-4, 6, 7, 11, 12, 14, 15 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Dahyanake (6482866).

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Dahayanake teaches a viscoelastic surfactant based fluid which comprises a zwitterionic or amphoteric surfactant within the scope of the present invention, and further comprises an organic acid and a salt (see examples, claims and columns 4-6). An alcohol is used to aid the solubilization of the surfactant (column 8, lines 14-19). The fluid is used in fracturing operations (column 2, lines 10-13). The present invention is thus anticipated by Dahayanake.

7. Claims 1, 2, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Lungwitz (US 2002/0033260 A1).

Lungwitz teaches a fluid which can be used in fracturing operations, which comprises a zwitterionic surfactant within the scope of the present invention, a salt brine, an acid and an organic solvent (see paragraphs 0043 - 0053 and claims).

Applicants foreign priority claim cannot overcome the present rejection, since a certified copy of such document has not been supplied.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3, 6-11 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahayanake (6482866).


Dahayanake teaches a viscoelastic surfactant based fluid which comprises a zwitterionic or amphoteric surfactant within the scope of the present invention, and further comprises an organic acid and a salt (see examples, claims and columns 4-6). An alcohol is used to aid the solubilization of the surfactant (column 8, lines 14-19). The fluid is used in fracturing operations (column 2, lines 10-13). Dahayanake teaches that the fluid may be foamed with a gas, such as air, nitrogen or carbon dioxide. Dahayanake differs from the present invention in that the specific amount of gas used in the foam is not disclosed. It would however be obvious to one of ordinary skill in the art to vary the amount of gas, in the foam, in order to achieve optimal foam properties for fracturing operations (In re Aller 105 USPQ 233).

10. Claims 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2753
March 7, 2003


PHILIP C. TUCKER
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